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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,207	02/20/2004	Jim B. Surjaatmadja	2003-IP-012367U1	6688

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EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,207	Applicant(s) SURJAATMADJA, JIM	
	Examiner Sharidan Carrillo	Art Unit 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/06/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12062004, 12172004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6-7 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Scapanski (6028113).

In reference to claims 1-3, Scapanski teaches a method of cleaning a hard surface by spraying a cleaning composition. Scapanski teaches dissolving a solid sanitizing composition with fresh water and spraying onto a surface (Abstract, Fig. 1, col. 4, lines 55-60, col. 7, lines 20-25, col. 10, lines 30-50, Example 9, col. 9, lines 5-10). In reference to claims 6-7, refer to col. 10, lines 5-15. In reference to claim 17, refer to col. 7, lines 30-31.

3. Claims 1-3, 5-13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Houghton et al. (EP0510762A2).

Houghton et al. teach a non-aqueous liquid cleaning composition comprising a particulate solid phase for cleaning hard surfaces or warewashing (Abstract, p. 4). The limitations of jetting would inherently be met since Houghton teaches using the composition for warewashing by mechanical means and automatic dishwashing machines perform jetting of the cleaning composition on the surface of the dishware. In reference to claims 2-3, refer to page 9. In reference to claim 5, refer to page 2. In reference to claim 6, refer to page 9, lines 30-32. In reference to claim 7, refer to page

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9, lines 30-35. In reference to claims 8-9, refer to page 4, lines 5-10. In reference to claims 10-13, refer to page 8, lines 25-28. In reference to claim 17, refer to page 8, lines 53-54.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 8, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Banerjee et al. (US2003/0188766A1).

Banerjee et al. teach cleaning a wafer surface by simultaneously jetting liquid in combination with carbon dioxide particles unto a surface (Fig. 1, paragraphs 17, 21, and 24). In reference to claim 8, refer to paragraph 17. In reference to claim 15, refer to paragraph 21. In reference to claim 16, refer to col. 3, lines 1-5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3, 5, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacVitte et al. (3272650).

In reference to claims 1-2, MacVitte et al. teach a method of cleaning an interior surface of a conduit by contacting with a liquid suspension comprising polymer particles (i.e. polycarbonate, col. 1, lines 35-42, col. 2, lines 7-13). In reference to claim 1, MacVitte et al. fail to teach jetting. However, applying fluid to a surface by spraying or jetting is conventionally and notoriously well known in the art as evidenced by Scapanski, or Banerjee et al., as previously discussed above. In reference to claims 2-

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3, MacVitte et al. teach using water. In reference to claim 14, refer to col. 3, lines 20-25.

In reference to claim 18, refer to col. 1, lines 35-40.

Response to Arguments

10. The rejections under 35 U.S.C. 112, first paragraph and second paragraph are withdrawn in view of arguments presented by applicant.

11. Applicant argues that Scapanski teaches an all liquid solution and that the embodiment directed to the use of tablets is not preferred. Scapanski teaches tablets that dissolve slowly in water. This is not different from applicant's specification which teaches in paragraph 19 that "degradable particles degrade slowly over time."

Applicant's arguments are unpersuasive since applicant is relying on preferred embodiments and not on the teachings of the reference as a whole. Col. 9, lines 10-13 teaches using pure powders. Col. 10, lines 25-29 teaches using a powdered form to form a semi-liquid mixture.

12. Applicant argues that Houghton teaches 2 groups of copolymers in comparison to applicant's invention which is directed to a solid polymer. Applicant's arguments are not persuasive because they are not commensurate in scope with the claimed invention. Applicant further argues that polymers suitable for the present invention are recited in paragraph 13 of the instant specification. It is noted that Houghton teaches the same polymers as recited in paragraph 14 of the specification.

13. Applicant argues that Banerjee fails to teach the limitations of claim 1. As previously presented Banerjee teaches cleaning by jetting with a liquid and solid carbon dioxide particles, the teachings of which read on the limitations of claim 1.

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14. Applicant argues that MacVitte teaches an inert organic material which must not react with or dissolve the suspended particles in comparison to applicant's invention directed to a degradable material degrading over time in the fluid. Applicant's arguments are unpersuasive since applicant is claiming the same composition as the prior art. Therefore, since applicant is claiming the same composition as the prior art, it is unclear how applicant's composition is different from the prior art since both MacVitte and the instant specification teaches the particle comprising polycarbonate.

Additionally, applicant's definition of degradation is not limited to the particles degrading in the presence of water. In paragraph 13, the materials can degrade when subjected to temperature treatments. Applicant's arguments are not persuasive since MacVitte teaches the same composition as that of the claimed invention. Therefore, particles in the specification may be degradable, not based on the dissolution with water, but degradable by thermal treatment and since the prior art teaches that the particle is not dissolved in water, does not mean that the particle is not degradable by other means, such as thermal treatment, especially since the prior art and the instant invention are claiming the same composition.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER